The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HEIDI KAY
and
RUSSELL FRADIN

Appeal No. 2002-2162
Application 09/216,206

ON BRIEF

Before JERRY SMITH, RUGGIERO and LEVY, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-13 and 19-23. Claims 14-18 and 24-28 have been withdrawn from consideration as being directed to a non-elected invention.

The disclosed invention relates to an on-line advertising system which includes a web server that stores advertisement

data, bidding agents which submit bids to display advertisements whenever there is a viewing opportunity (view-op), and bid selection logic for deciding which bid to accept for a particular view-op. When a view-op occurs that meets a bid specification, the view-op is further evaluated to determine the comparative effectiveness of the particular advertisement on each of the sites on which the advertisement was previously displayed.

Representative claim 1 is reproduced as follows:

1. A system for making advertisements available to web sites on the Internet which includes:

a web server which stores advertisements,

means for supplying selection criteria for view-ops which have particular characteristics, and bid selection logic which makes calculations as each view-op is presented to determine if an advertisement should be supplied in response to a particular view-op, said calculations being a function of results achieved by each display of the particular advertisement on the same site previously.

The Examiner relies on the following prior art:

Hanson et al. (Hanson)	5,974,398	Oct. 26, 1999 (filed April 11, 1997)
Gerace	5,991,735	Nov. 23, 1999 (filed Aug. 11, 1998)

Claims 1-13 and 19-23 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanson in view of Gerace.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (Paper No. 17) and Answer (Paper No. 18) for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, the arguments in support of the rejection, and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Brief have not been considered [see 37 CFR § 1.192(a)].

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-13 and 19-23. Accordingly, we affirm.

Although Appellants nominally indicate (Brief, page 4) that the appealed claims are separately patentable from each other, separate arguments have been made only for independent claims 1 and 19, argued collectively as a group, and dependent claims 3 and 8-10, also argued collectively as a group. Accordingly, since both the Examiner and Appellants have addressed independent claim 1 in their arguments, we will consider claim 1 as representative of all claims on appeal, with the exception of collectively argued dependent claims 3 and 8-10. Claims 2, 4-7, 11-13, and 19-23 will stand or fall with claim 1. Similarly, claims 8-10 will stand or fall with claim 3, which we will select as the representative claim for the argued grouping of claims 3 and 8-10. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

With respect to representative claim 1, Appellants' arguments (Brief, pages 4 and 5) in response to the Examiner's obviousness rejection initially focus on the contention that, while Hanson considers a user's profile in determining an amount for an advertiser to bid for the user to view their advertisement, there is no disclosure of any consideration of the effectiveness of previous displays of the advertisement as

claimed. Appellants further contend (Id.) that, in contrast to the claimed invention in which advertisements are made available to a web site, Hanson's system makes determinations on advertisements presented to an on-line service provider.

After careful review of the Hanson reference, we find neither of Appellants' arguments to be persuasive. While Hanson indeed has abundant disclosure of the use of historical user profile information in determining the scheduling of advertisements displayed to a user, as acknowledged by Appellants, we also find ample teaching and suggestion in Hanson of the use of an effectiveness measure to determine advertisement scheduling. For example, Hanson, at column 5, lines 12-16 states "[i]nformation regarding the number of times a particular advertisement is viewed, by whom and at what times, and whether viewed previously by a particular user, may be optionally stored in advertiser offers database **106**." Further, Hanson, at column 8, lines 8-24, describes the adjustment of an advertiser's bid based on the number of times an advertisement is viewed. In describing the advantages of such a feature, Hanson states "[a] particular advantage of the present invention is that advertisers

are able to receive feedback on the effectiveness of a particular advertisement quickly." (Hanson, column 8, lines 28-32, emphasis added).

Similarly, we find to be without merit Appellants' further contention that, contrary to the claimed invention in which usage of a web site is tracked and recorded to determine the suitability of advertisements for that web site, Hanson is concerned with providing advertisements to a service provider. Our review of the disclosure of Hanson finds us in agreement with the Examiner (Answer, page 9), i.e., Hanson provides for tracking the usage of a web site (e.g., the tennis bulletin board illustrated in Figures 4 and 5), not an on-line service provider as asserted by Appellants, in order to determine how to adjust bids for advertisements on that web site.

We are further of the view, after reviewing the collective teachings of the Hanson and Gerace references, that while the Examiner has added Gerace to the teachings of Hanson as providing a suggestion of an effectiveness factor in determining scheduling of advertisements to be viewed on a web site, we consider the effectiveness determination teachings of Gerace to be cumulative with respect to Hanson as discussed supra. Accordingly, since its effectiveness factor teachings are cumulative to those of

Hanson, Gerace is not necessary for a proper rejection under 35 U.S.C. § 103(a) of representative claim 1 since Hanson appears to disclose all that is claimed. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).[1] Accordingly, the Examiner's obviousness rejection of representative claim 1, and claims 2, 4-7, 11-13, and 19-23 which fall with claim 1, is sustained based on Hanson alone.

We also sustain the Examiner's 35 U.S.C. § 103(a) rejection of representative dependent claim 3, which adds the feature of the use of an initialization period before advertizing scheduling determinations are made, as being unpatentable over Hanson in view of Gerace. At the outset, we find no error, and Appellants' arguments have pointed to none, in the Examiner's line of

[1] The Board may rely on less than all of the references applied by the Examiner in an obviousness rationale without designating it as a new ground of rejection. In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); In re Boyer, 363 F.2d 455, 458, n.2, 150 USPQ 441, 444, n.2 (CCPA 1966).

reasoning (Answer, page 5) which establishes a motivation for combining Hanson with Gerace.

We further find no error in the Examiner's position that Gerace's initial evaluation period, which is defined by a predetermined number of "hits" after which a regression analysis is performed to establish weighting factors for refining an advertizing bid, corresponds to Appellants' initialization period as claimed. Notwithstanding Appellants' arguments (Brief, page 6) which call attention to the fact that Gerace's information updating is performed at scheduled intervals, we fail to see why the fact that the regression analysis in Gerace is performed after a scheduled number of "hits" would prevent this initial evaluation period from being considered an "initialization" period as claimed. Accordingly, since it is our opinion that the Examiner's prima facie case of obviousness has not been overcome by any convincing arguments from Appellants, the Examiner's 35 U.S.C. § 103(a) rejection of representative dependent claim 3, as well as claims 8-10 which fall with claim 3, is sustained.

In summary, we have sustained the Examiner's 35 U.S.C. § 103(a) rejection of all of the claims on appeal. Therefore,

the decision of the Examiner rejecting claims 1-13 and 19-23 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JERRY SMITH)
Administrative Patent Judge)
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JOSEPH F. RUGGIERO) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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